

3-26-07

Attorney's Docket No.: 17106-017001 / 1607

~~DAE~~
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Madison *et al.*
Serial No. : 09/776,191
Filed : February 2, 2001
Title : **NUCLEIC ACID MOLECULES ENCODING TRANSMEMBRANE
SERINE PROTEASES, THE ENCODED PROTEINS AND METHODS
BASED THEREON**

Art Unit : 1652
Examiner : Yong D. Pak
Conf. No. : 3237

MAIL STOP PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

Transmitted herewith are a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed January 23, 2007; a check for \$200 for the requisite petition fee; and a return postcard in connection with the above-captioned patent application. If a Petition for extension of time is needed, this paper is to be considered such Petition.



The Commissioner is hereby authorized to charge any fee, including that submitted herewith if the attached check(s) is in the wrong amount or otherwise improper or missing, that may be due in connection with this and the attached papers, or with this application during its entire pendency or to credit any overpayment to Deposit Account No. 06-1050. A duplicate of this sheet is enclosed.

Respectfully submitted,
Fish & Richardson P.C.

Stephanie Seidman
Reg. No. 33,779

Attorney Docket No. 17106-017001 / 1607

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" Mailing Label Number EV 965982435 US
Date of Deposit: **March 23, 2007**

I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Mail Stop Petition, Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Frank J. Miskiel

Attorney's Docket No.: 17106-017001 / 1607

REMARKS

A check for the requisite fee for filing this petition is attached. Any fees that may be due in connection with the filing of this paper or with this application may be charged to Deposit Account No. 06-1050. If a Petition for Extension of Time is needed, this paper is to be considered such Petition.

It respectfully is submitted that the Office Action, mailed January 23, 2007, which was made Final, introduces a new ground of rejection of claims 1-3, 19 and 20 under 35 U.S.C. §102(b) that was not necessitated by amendment and that could have been applied in a previous Office Action. Therefore, the Action should not have been made Final.

In the instant Office Action, the Examiner has newly rejected claims 1-3, 19 and 20 under 35 U.S.C. §102(b) over Dawson *et al.* (U.S. Pat. No. 5,645,833). The Examiner alleges that Dawson *et al.* discloses a polypeptide consisting of a serine protease domain of an MTSP protein. The Examiner alleges that the amendments of the claims necessitate the new ground of rejection. Applicant respectfully submits that, to the extent that this ground of rejection is proper, it could have been applied to claims in the previous Office Action.

In the response filed to the previous Office Action, claim 1 was amended to incorporate the limitations of claim 5, which stated that the substantially purified polypeptide of claim 1 consists of the protease domain of an MTSP or a catalytically active portion of the protease domain. Hence claim 1 is substantially the same as prior pending claim 5.

In particular, **claim 5** as previously pending recited:

The substantially purified polypeptide of claim 1 that consists of the protease domain of an MTSP or a catalytically active portion of the protease domain.

Claim 1 was amended to incorporate the limitation of claim 5 that recites that the polypeptide "consists of the protease domain." Claim 1 also was amended for clarity to reference the antecedent recitation in the preamble of "single-chain" in the body of the claim, and to delete now-extraneous language. In particular, claim 1 was amended as follows to recite:

***An isolated, substantially purified single-chain polypeptide, comprising
consisting of a protease domain of a type-II membrane-type serine protease (MTSP)
or a catalytically active fragment thereof as a single chain, wherein wherein:
the MTSP protease domain or catalytically active fragment thereof is the only
portion of the single-chain polypeptide from the MTSP; and
the MTSP protease domain or catalytically active fragment thereof has serine
protease activity as a single chain.***

Thus, claim 1 as amended recites the limitation of claim 5 that the polypeptide "consists of the protease domain."

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Petition for Removal of Premature Final Rejection

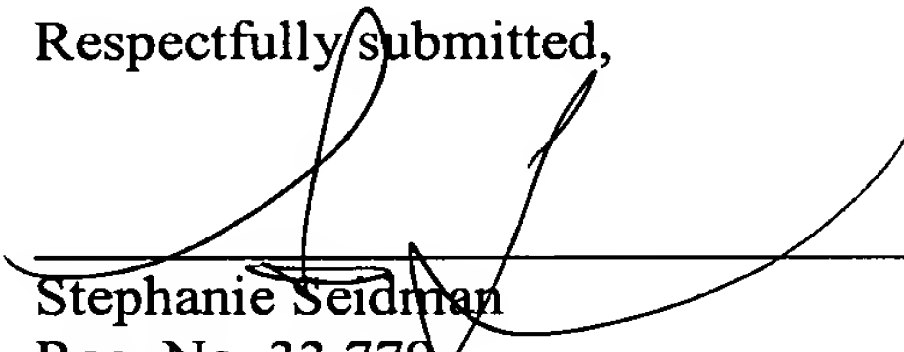
As noted above, claim 1, as well as dependent claims, newly are rejected over Dawson *et al.* because Dawson *et al.* allegedly discloses a polypeptide **consisting of** a serine protease domain of an MTSP protein. Claim 5 as previously pending was directed to a polypeptide "consisting of the protease domain of an MTSP" protein. Thus, to the extent this rejection is pertinent to pending claim 1, previously pending claim 5 could have been so-rejected. Therefore, the new ground of rejection is not necessitated by the amendment of claim 1. Claim 5 previously could have been so-rejected.

Failure to withdraw the finality of the Office Action denies the Applicant the right to amend the claims, if needed, and/or provide arguments to overcome this new rejection. Therefore, since the newly recited rejection of claims 1-3, 19 and 20 under 35 U.S.C. §102(b) was not necessitated by amendment and could have been raised in a previous Office Action, the finality of the Office Action is improper.

* * *

In light of the above remarks, removal of the finality of the Office Action is respectfully requested.

Respectfully submitted,



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Reg. No. 33,779

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